

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
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Renato CAPONI et al.)	Group Art Unit: 3663
)	
Application No.: 10/568,080)	Examiner: DIACOU, Ari M.
)	
Filed: February 13, 2006)	
)	
For: MULTI-STAGE OPTICAL)	Confirmation No.: 7439
AMPLIFIER OPTIMIZED WITH)	
RESPECT TO NOISE, GAIN AND)	
BANDWIDTH)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In the restriction requirement dated August 9, 2007, the Examiner made a restriction under 35 U.S.C. § 121 to one of the following claim groups:

Group A: The alleged species wherein the third amplifier stage is a Raman amplifier.

Group B: The alleged species wherein the third amplifier stage is a rare-earth-doped fiber amplifier.

The Examiner did not identify any pending claims in either of these two identified claim groups. Rather, the Examiner required Applicants to (i) elect one of the claim groups for examination, and (ii) identify which claims encompass the elected claim group. See Office Action dated August 9, 2007, at 2-3.

Claims 29-56 are currently pending, of which only claim 29 is independent.

Because dependent claims 44 and 45 are the only pending claims that explicitly recite, for example, “wherein said silica-based fiber of said third amplifying stage is a rare-earth doped active fiber,” (i.e., Group B), Applicants provisionally elect with traverse to prosecute claims 29-43 and 46-56 in Group A, allegedly drawn to a species wherein the third amplifier stage is a Raman amplifier.

In order for the restriction requirement to be proper, two criteria must be satisfied: the restricted inventions must be independent or distinct, and there must be a “serious burden on the examiner if restriction is not required.” M.P.E.P. § 803(I). Applicants respectfully traverse the pending restriction at least because neither of these two criteria is satisfied for the pending claims.

First, the Examiner has not established that claims in Groups A and B are independent or distinct. Rather, all of the pending claims 29-56 comprise, among other things, “said third amplifying stage including a silica-based fiber,” as recited in independent claim 29. The claimed “silica-based fiber” may be embodied in various forms including, for example, “a rare-earth doped active fiber” (e.g., as recited in dependent claim 44), or “a Raman-active fiber” (e.g., as recited in dependent claim 49). Because the various possible embodiments of the claimed “silica-based fiber” are connected in design, operation, or effect, they do not constitute independent or distinct inventions. See, e.g., M.P.E.P. § 806.04(b).

Second, examination of dependent claims 44 and 45 (i.e., Group B) would not impose any serious additional burdens on the Examiner. As noted above, a proper examination of the “silica-based fiber” recited in independent claim 29 (in Group A)

requires the Examiner to search the technical areas of both rare-earth-doped and Raman-active fibers (i.e., Groups A and B). Consequently, an examination of the restricted dependent claims 44 and 45 would not seriously broaden the scope of the Examiner's search or consideration. M.P.E.P. § 803 ("If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent and distinct inventions").

Finally, independent claim 29 is a "linking claim" that recites, for example, "a silica-based fiber" that links the alleged species associated with Groups A and B. Therefore, the Examiner will be required to withdraw the pending restriction requirement, in the event that independent claim 29 remains a linking claim and becomes allowable. See, e.g., M.P.E.P. § 809 ("When all claims directed to the elected invention are allowable, should any linking claim be allowable, the restriction requirement between the linked inventions must be withdrawn").

More generally, Applicants point out that many of the claims in elected Group A are generic (genus) claims that are not limited to Raman amplifiers or rare-earth-doped fiber amplifiers. For example, independent claim 29 recites, among other things, "said third amplifying stage including a silica-based fiber." Dependent claim 44 depends on independent claim 29 and further recites, *inter alia*, that the claimed "silica-based fiber" may be a "rare-earth doped active fiber." Dependent claim 49 also depends on independent claim 29 and recites, *inter alia*, that the claimed "silica-based fiber" may be a "Raman-active fiber." Accordingly, at least dependent claims 44 and 49 clarify that the "silica-based fiber" recited in independent claim 29 of Group A covers both rare-


earth-doped active fibers as well as Raman-active fibers, making claims of Group B allowable upon the allowability of claim 29 in Group A.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: September 25, 2007

By: 

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